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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,015	02/07/2001	Jun Suzuki	Q62980	6229

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SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
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EXAMINER

LETSCHER, GEORGE J

ART UNIT PAPER NUMBER

2653

DATE MAILED: 05/20/2004

*[Handwritten signature]*

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/778,015

Applicant(s)

SUZUKI ET AL

Examiner

George J. Letscher

Art Unit

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 3-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Shinozuka et al '728.

Claims 3-5 recite the following elements, inter alia, disclosed in Shinozuka et al '728: a lens device (1) having an objective lens (2) and drive coils (12, 13) fixed to the lens holder (3); a plurality of wire-form elastic members (6) made of metal which energize the drive coils. The lens holder is made of resin and integrally molded (i.e., integral – a complete unit: whole; and mold – to fit closely; therefore, to fit closely as a complete unit) with connection wires 48 via adhesive; see column 12, lines 10-26. This connects the wires 6 to the drive coils 12,13 and the lens holder. Two ends of the lens holder are exposed so that they are connection terminals to the drive coils. The lens and

drive coils are fixed on the lens holder. See Figures 2-3 & 7-8 of Shinozuka et al '728.

In an alternative interpretation, regarding the method of a molded structure, as the claims are directed to a lens drive device product, per se, the method limitation(s) appearing in lines 2 and 3 of claims 2 and 3 can only be accorded weight to the extent that it/they affect(s) the structure of the completed tunneling sensor. Note that "[d]etermination of patentability in 'product-by-process' claims is based on product itself, even though such claims are limited and defined by process [i.e., "masking"], and thus product in such claim is unpatentable if it is the same as, or obvious form, product of prior art, even if prior product was made by a different process", *In re Thorpe, et al.*, 227 USPQ 964 (CAFC 1985). Furthermore, note that a "[p]roduct-by-process claim, although reciting subject matter of claim in terms of how it is made [i.e., "masking"], is still a product claim; it is patentability of product claimed and not recited process steps that must be established, in spite of fact that claim may recite only process limitations", *In re Hirao and Sato*, 190 USPQ 685 (CCPA 1976).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinozuka et al '728 in view of Applicant's Prior Art in Figure 1 and pages 7-9 of the specification.

The description of Shinozuka et al '728 is in paragraph 3, supra.

Regarding claim 1, Shinozuka et al '728 do not teach an end of the wire-form elastic members buried within each of the fixing arms.

Applicant's Prior Art of Figure 1 and pages 7-9 of the specification shows an end of the wire-form elastic members (6a-d) buried within each of the fixing arms (9); see Figure 1 of Applicant's Prior Art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have furnished the optical disc lens drive device having wire-form elastic members integrally connected with fixing arms as shown by Shinozuka et al '728 with an end of the wire-form elastic members buried within each of the fixing arms as taught by Applicant's Prior Art of Figure 1 and pages 7-9 of the specification. The rationale is as follows: one of ordinary skill in the art would have been motivated to have furnished the optical disc lens drive device having wire-form elastic members integrally connected with fixing arms as shown by Shinozuka et al '728 with an end of the wire-form elastic members buried within each of the fixing arms as taught by Applicant's Prior Art of Figure 1 and pages 7-9 of the specification since one of ordinary skill in the art recognized that the wires stably supported the moving unit while feeding the drive current to the focusing coil and tracking coils and provided enhanced operational reliability in the lens drive unit.

***Response to Amendment***

6. Applicant's arguments filed 3/15/04 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claim 1 have been considered by the Examiner but are not deemed persuasive for the following reasons:

a) Integrally molded is defined as "closely fit complete unit" based on integral (a complete unit: whole) and mold (to fit closely).

b) In an alternative interpretation, the method of molding is only accorded weight as described in the rejection of record above. Also, it is noted by the Examiner that the MPEP 2113 states "[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make

physical comparisons therewith.” In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

In response to Applicant’s allegation on page 5 of the remarks that the Examiner “appears to “ignore” this limitation”, it is pointed out that the limitation was not ignored, merely given its accorded weight in accordance with the MPEP and its cited case law.

On page 6, paragraph 1, Applicant asserts that “integrally molded has a tight configuration and may not be dependent upon adhesive to maintain its connection.” Firstly, the Examiner notes that “may not be dependent upon adhesive ...” is not set forth in the claims. Secondly, the Examiner provided a literal, i.e., dictionary, definition of “integrally molded” in the rejection as “fit closely as a complete unit.” Therefore, a molded structure is a structure that is fit closely.

### **Conclusion**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH**




shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Letscher whose telephone number is (703) 305-7912.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4750.

George Letscher  
May 19, 2004



**George Letscher**  
**Primary Examiner**  
**AU 2653**